

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

YOR920010696US1

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on _____

Signature _____

Typed or printed name _____

Application Number

09/982,225

Filed

October 18, 2001

First Named Inventor

Felton, et al.

Art Unit

3628

Examiner

Jennifer L. Liversedge

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Duane N. Moore/

Signature

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Duane N. Moore

Typed or printed name

☒ attorney or agent of record.
Registration number 53,352

(410) 573-6501

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☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

December 6, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Felton et al.

Atty. Docket No.: YOR920010696US1

Serial No.: 09/982,225

Group Art Unit: 3628

Filed: October 18, 2001

Examiner: Liversedge, Jennifer, L.

For: IMPORT DECLARATION/FOREIGN SUPPLIER INVOICE PAYMENT
RECONCILIATION PROCESS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This Pre-Appeal Brief Request is being submitted together with a Notice of Appeal and is in response to the Office Action mailed September 6, 2007, setting a three-month statutory period for response. Therefore, this Request is timely filed.

Claims 1, 3-14, and 16-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Walker, et al (U.S. Publication No. 2002/0095355), hereinafter referred to as Walker, in view of Official Notice. Applicants respectfully traverse these rejections based on the following discussion.

Applicants respectfully traverse these rejections because the rejections contain two clear errors. First, Walker is not prior art under 35 U.S.C. §103(a). Secondly, the prior art of record misses the claim element wherein the inputting of the first value comprises inputting a value claimed on an import declaration, the inputting of the second value comprises inputting a value claimed on a payment invoice, alerting a user if the

first value does not equal the second value, and making an automated payment if the first value equals the second value.

A. Walker is not prior art under 35 U.S.C. §103(a).

Applicants submit that Walker is not prior art under 35 U.S.C. §103(a) and has a filing date after the filing date of the present application. Moreover, the provisional on which Walker was based does not include the disclosure relied upon in the rejection.

The claimed invention provides methods for verifying a value of goods on a supplier invoice. First, the method compiles daily input of supplier invoice data into a weekly statistical sample of supplier invoices. The sampling size equals exactly a total number of all supplier invoices compiled. A first value (import declaration value) and a second value (payment invoice value) of imported goods are inputted. If the first value does not equal the second value, then a user is alerted; if the first value equals the second value, then an automated payment is made.

First of all, Applicants submit that portions of Walker relied upon by the Office Action do not constitute prior art under 35 U.S.C. §103(a). More specifically, the Office Action relies upon paragraph 0014 of Walker to reject Applicants' claims (Office Action, p. 3). However, paragraph 0014 of Walker was not disclosed in the provisional application of Walker (No. 60/262,484), which was filed on January 18, 2001, nor were any similar statements or concepts. Moreover, Applicants' filing date of October 18, 2001 precedes Walker's filing date of July 18, 2002. Accordingly, Applicants submit that Walker's teaching of "[p]ayment on the part of the buyer and collection on the part of the seller are finalized" (para. 0014) was not disclosed prior to Applicants' filing date;

and, as such, does not constitute prior art under 35 U.S.C. §103(a).

The Office Action argues that the use of paragraph 0014 of Walker is proper “because the paragraph is within the Description of Prior Art section of the disclosure” (Office Action, p. 5, para. 3). Thus, the Office Action reasons that “Walker is not disclosing a new form of payment ... but is stating [the] prior art” (Office Action, p. 5, para. 3).

Applicants submit that regardless of what Walker is stating in paragraph 0014, whatever paragraph 0014 states was disclosed after Applicants’ filing date because nothing similar to paragraph 14 appears in Walker’s provisional. In other words, no matter what is stated in paragraph 0014 of Walker, paragraph 0014 does not constitute prior art under 103 because it was filed after Applicants’ filing date, and does not appear in the provisional.

A reference having a date of January 17, 2002 is not a prior art reference for an application filed on October 18, 2001. The only thing that Walker shows is what was known before January 17, 2002, which could mean January 16, 2002 (well after the filing date of the present application). Therefore, the portion of Walker relied upon in the Office Action is not prior art.

B. Missing Claim Element – said inputting of said first value comprising inputting a value claimed on an import declaration, said inputting of said second value comprising inputting a value claimed on a payment invoice, alerting a user if said first value does not equal said second value, and making an automated payment if said first value equals said second value.”

In addition, Applicants traverse the rejections because Walker fails to disclose the claimed features wherein “said inputting of said first value comprising inputting a value claimed on an import declaration ... said inputting of said second value comprising inputting a value claimed on a payment invoice ... alerting a user if said first value does not equal said second value; and making an automated payment if said first value equals said second value” (independent claims 1, 8, 14).

On page 6, paragraph 2, the Office Action argues that Walker discloses declarations (para. 0087) and payment invoices (para. 0050). However, Walker fails to disclose comparing the value claimed on an import declaration with the value claimed on a payment invoice, wherein a user is alerted if the values are not equal, and wherein an automated payment is made if they are equal. The Office Action argues that such features are disclosed in paragraphs 0087-0088 of Walker (Office Action, p. 6, para. 2). Applicants respectfully disagree and submit that nothing within Walker, including the portions cited by the Office Action, compares the value claimed on an import declaration with the value claimed on a payment invoice.

Instead, Walker only discloses reviewing compliance for “labeling/packaging, product certifications, pre-shipment inspections, origin certifications, import licenses/quotas, hazmat labeling/packaging, declarations, export licensing/restrictions, and country/region/international standards” (Walker, para. 0087). Walker also discloses “additional compliance activities, such as product marking or additional declarations or certifications, facilitates allocating the responsibilities for each activity to either the buyer or seller, and captures and itemized any additional costs associated with each compliance activity” (Walker, para. 0088).

None of the compliance regulations discussed in Walker relate to whether the value claimed on an import declaration matches the value claimed on a payment invoice. Therefore, it is Applicants' position that Walker fails to disclose the claimed features wherein "said inputting of said first value comprising inputting a value claimed on an import declaration ... said inputting of said second value comprising inputting a value claimed on a payment invoice ... alerting a user if said first value does not equal said second value; and making an automated payment if said first value equals said second value" (independent claims 1, 8, 14).

In view of the foregoing, all the rejections should be removed and the application should be passed to issuance.

Please charge any deficiencies and credit any overpayments to Attorney's Deposit Account Number 50-0510.

Respectfully submitted,

/Duane N. Moore/

Dated: 12/6/07

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